

Application No.: 10/520,944Docket No.: 4444-051**REMARKS**

The examiner is requested to approve changing the symbol SO in the drawing to SQ so the drawing and the specification are consistent. To this end applicant submits a new sheet enjoying with the drawing change, based on the assumption the change will be approved.

The allowance of claim 39 and the indication of claim 21 containing allowable subject matter are noted. Applicant is not understand the comment on page 4 that claim 21 would be allowable if rewritten to overcome the rejection under 35 USC 112, second paragraph. In this regard, there is no rejection of claim 21 or any claim upon which claim 21 depends under 35 USC 112, second paragraph.

Claims 23, 24, 35 and 36 have been canceled and replaced by new claims 40-43. New claims 40-43 do not require consideration of new issues or a new search because the subject matter thereof was previously included, *inter alia*, in claims 22 and 23. Consequently, entry of the amendment is in order.

Applicant traverses the rejection of claims 36 and 38 on a 35 USC 112, second paragraph. The office action states "Claims 36 and 38 are unclear as claim 33 appears to be a subcombination justice structure to be carried on the vessel...". This comment is not understood because claim 33 has been canceled and there is no reference in either claim 36 or claim 38 to claim 33. In any event, former claim 36, that is now similar to new claim 42, is directed to a structure adapted to be carried on a vessel and thus is directed to a subcombination. Such a claim is important to enable the claim to cover a collecting structure before it is installed on a vessel, so that the owner of applicant's

Application No.: 10/520,944

Docket No.: 4444-051

AMENDMENTS TO THE DRAWINGS:

The attached sheets of drawing include changing SO to SQ.

Attached: New Figs. 1-5

Application No.: 10/520,944Docket No.: 4444-051

patent can charge direct infringement of makers and sellers of the structure before the structure is installed on a vessel.

The situation with regard to claim 42 is similar to that faced by the court in *In re Venezia*, 530 F.2d 956, 189 USPQ149 (CCPA 1976). In that case, the claim was directed to a kit of components parts, capable of being assembled. The court held that limitations such as "members adapted to be positioned" and "portions... being reasonably in the dilatable whereby said housing may be slightly positioned" precisely defined present structural attributes of interrelated components parts of the claimed assembly; see MPEP 2173.05 (g). Similarly, *Ex parte Nolden*, 149 USPQ 378, 380 (Board of Patent Appeals 1965) held is not essential to a patentable combination that there be into dependency between the elements of the claim device or that all the elements operate concurrently toward the desired result. To a similar effect is *Ex parte Huber*, 148USP Q447, 448-449 (Board of Patent Appeals 1965) held a claim does not necessarily fail to comply with 35 USC 112, second paragraph where the various elements do not function simultaneously, are not directly functionally related, do not directly cooperate and/or serve independent purposes. Based on the foregoing, claim 42 and claim 43 that depends on claim 42 comply with 35 USC 112, paragraph 2.

New claims 40 and 42 are not rendered obvious by the various combination of references set forth in the final rejection.

Claim 40 indicates the water flowed shall and the turbine are arranged for causing (a) liquid was liquid wastes and liquid with that liquid waste to flow together in a

Application No.: 10/520,944Docket No.: 4444-051

first part of a water flow channel between a water inlet of a vessel and a water outlet of the channel, (b) the liquid was liquid wastes and liquid with that liquid waste to be separated downstream of the first part of the channel into first and second trajectories, respectively, (c) the liquid in the first trajectory to flow into a floating liquid waste holding tank, (d) the liquid emerging from the tank, without liquid waste and in the first trajectory, to flow through a turbine that creates a water flow in the water flowed shall and causes liquid flowing through the channel outlets to flow through the turbine, thence outboard of the vessel and (e) the liquid in the second trajectory to flow downstream of the first part of the channel to by-pass the tank and to flow through the turbine. In addition, the tank is formed to cause liquid in the first trajectory in the tank to flow with a Venturi effect. Claim 42 includes similar limitations, without specifically requiring the apparatus to be located on a vessel.

New dependent claims 41 and 43 indicate a solid waste retainer is located between the vessel inlet and the first part of the channel. The solid waste retainer causes liquid including liquid wastes and solid waste to flow from the water inlet of the vessel into the solid waste retainer and liquid in the first and second trajectories to flow from the solid waste retainer. The first part of et al. is required to be downstream of the solid waste retainer.

The foregoing limitations of the new claims are similar to limitations of former claim 23 that indicates a solid waste retainer is upstream of the water flow channel and that the first and second trajectories of the channel are coincident between the inlet of

Application No.: 10/520,944Docket No.: 4444-051

the channel and an outlet of the solid waste retainer. Applicant notes such limitations of claim 23 are not actually discussed in the final rejection. Hence, it appears the examiner concedes that the features of claim 23 were not in the art relied on in the various rejections against claim 23, namely the rejection of claims 20, 22-24, 26-30, 32 and 35-38 based on Petchul, US patent 3,966,615 in view of Chastan-Bagnis, US patent 4,921,605 or the rejection of claims 22-25 based on Petchul in view of Debellian 5,173,182.

In the primary reference, Petchul, the excess water is removed by suction means 37 from the oil holding tank; column 3, lines 27 and 28. The water without waste, indicated by arrow 41, and which bypasses the holding tank flows out through a vent; column 2, lines 55 and 56. Consequently, the primary reference fails to disclose the requirements of claims 40 and 42 for liquid in the second trajectory to flow downstream of the first part of the channel to by-pass the tank and to flow through a turbine through which the liquid emerging from the tank, without liquid waste flows, and for the tank being formed to cause liquid in the first trajectory in the tank to flow with a Venturi effect. Modification of Petchul as result of the secondary references to obtain the foregoing features of claims 40 and 42 was unobvious to one of ordinary skill in the art.

The comment in the office action that Petchul inherently provides a tank having flow with a Venturi effect is without foundation. The arrows in the drawing of the reference merely indicate flow direction. The statement that the surface area of the holding tank decreases as the depth increases is inaccurate as an inspection of Figure

Application No.: 10/520,944Docket No.: 4444-051

Inspection of Figure 1 reveals. Wall 26 of the holding tank tapers toward the bow of the vessel as the depth of the holding tank increases, and the rear wall of the holding tank is substantially vertical. Consequently, the surface area of the Petchul holding tank increases as the depth of the tank increases. As result, the statement in the penultimate paragraph on page 4 of the office action is incorrect.

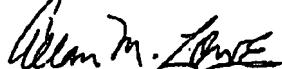
The dependent claims are allowable for the same reasons advanced for independent claims 40 and 42.

Entry of the amendment and allowance of the application are in order.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

LOWE HAUPTMAN HAM & BERNER, LLP



Allan M. Lowe
Registration No. 19,841

USPTO Customer No. 22429
1700 Diagonal Road, Suite 300
Alexandria, VA 22314
(703) 684-1111
(703) 518-5499 Facsimile
Date: October 9, 2007
AML/cjf